



I

where each R is independently hydrogen or -OR₁, each R₁ is independently hydrogen or CH₂COOR₂ and each R₂ is independently hydrogen, C₁-C₆ alkyl, C₁-C₆ alkenyl, C₁-C₆ alkynyl, C₆ aryl, or C₆-C₉ aralkyl, with the proviso that at least R₁ be CH₂COOR₂.

In addition, I am enclosing a reprinted version of claim 15 as per the Examiner's request. There are no changes in this claim when compared to claim 15 as filed.

REMARKS

Claim 1 has been amended to include the proviso that at least one R₁ group be CH₂COOR₂. Support for this amendment to claim 1 can be found in claim 1 as filed, which filed claim indicates that each R₁ group can independently be hydrogen or CH₂COOR₂ and that the particular value of R₁ is independent of the values of the other R₁ groups. In other words, as originally submitted, the four R₁ groups shown in the structure can be any combination of hydrogen and CH₂COOR₂. No new matter has been

added as a result of this amendment. Claims 1-15 are presently before the Examiner. Applicants respectfully request reexamination and reconsideration of the claims in their presently amended form.

Rejections Under 35 U.S.C. §101/112

The Examiner has rejected claims 1-15 under 35 U.S.C. §101 as allegedly lacking either a specific asserted utility or a well established utility. The Examiner maintains a similar rejection for an identical reason under the first paragraph of 35 U.S.C. §112. Applicants argue against this rejection for the reasons set forth below.

The presently pending claims provide core molecules for the construction of combinatorial libraries. As such, the claims compounds provide immediate benefit and utility to the public. One wishing to construct a combinatorial library simply need to provide a compound of the present invention and proceed to build a desired library. It is immaterial whether the constructed library is shown to have diagnostic therapeutic or any other utility. Compounds of the present invention are not intermediaries used to make a final product having some specified utility. Rather, the claim compounds provide a scaffolding upon which large numbers of compounds can be affixed. In this sense, a compound of the present invention is analogous to any other scaffold such as a coded bead, a chromatography column and the like. The assertion by the Examiner that such scaffolds have no immediate benefit to the public is not well taken. Applicants therefore respectfully request withdrawal of this §101/112 utility rejection.

Rejections Under 35 U.S.C. §102

The Examiner has rejected claims 1, 2 and 4 under 35 U.S.C.

§102(b) as allegedly being anticipated by United States Patent No. 3,071,591 ('591 Patent). The Examiner has further rejected claims 1, 2 and 4 under 35 U.S.C. §102(b) as allegedly being anticipated by Smeets, et al. (hereinafter Smeets). Applicants argue against this rejection for the reason set forth below.

None of the art relied upon by the Examiner teaches a compound of structure I (claim 1) wherein at least one of the R_1 groups has a value of CH_2COOR_2 . Therefore none of that art can anticipate the presently claimed invention. Applicants therefore respectfully request withdrawal of the §102 rejections.

SUMMARY

In view of the amendments to the claims and for the reasons set forth above, Applicants respectfully submit that the claims are now in a condition of allowance. An early notification to that effect is hereby earnestly solicited.

Respectfully submitted,

Dated: 12-13-2000

By Thomas E. Northrup

Thomas E. Northrup, Reg. No. 33,268

THE SCRIPPS RESEARCH INSTITUTE
Office of Patent Counsel
10550 North Torrey Pines Road
Mail Drop TPC-8
La Jolla, CA 92037
(858) 784-2937